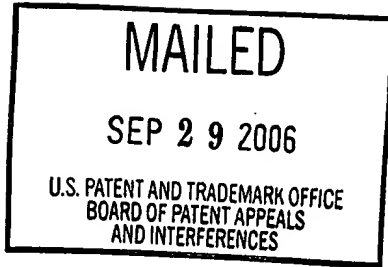


The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte BRUCE L. ADAMS and IRWIN PEARL

Appeal No. 2005-1938
Application No. 09/294,461
Technology Center 3600

ON BRIEF

Before HAIRSTON, GROSS and LEVY, *Administrative Patent Judges*.
GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 29 through 40, which are all of the claims pending in this application.

Appellants' invention relates to a system for generating personalized shopping lists and distributing coupons matched to planned purchases. Claim 29 is illustrative of the claimed invention, and it reads as follows:

29. A system for generating personalized shopping lists and distributing coupons matched to planned purchases, comprising:

a plurality of consumer units each operable by consumers and comprising a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit connected to the display monitor and the memory and having communication means connectable over a communication medium to at least a coupon

server, and a user input device to permit a consumer to make one or more selections from choices displayed on the display monitor;

a coupon server located remotely from the consumer units and comprising a memory for storing data corresponding to a plurality of participating retail outlets including data identifying each of the retail outlets by name, inventory of goods offered for sale, and aisle location of the goods in the participating retail outlets, and for storing coupon data used for generating electronic discount coupons for selected goods, and a data processing unit having communication means connectable over the communication medium to the consumer units, the coupon server further comprising

first means responsive to a connection with a respective consumer unit to transmit for display on the display monitor of the respective consumer unit a first file containing a list of the participating retail outlets which may be individually selected by the consumer using the user input device of the respective consumer unit,

second means for transmitting to the respective consumer unit for display on the display monitor thereof a second file containing one of a list of the inventory of goods offered for sale by a selected retail outlet or a list of goods generally sold in retail outlets of a particular type, the displayed list of goods being individually selectable by the consumer using the user input device, and

third means responsive to the selection of one or more items of goods by the consumer to transmit to the respective consumer unit data corresponding to the selected goods including coupons for one or more of the selected goods, or, if such coupons are not available for the selected goods at a selected retail outlet, coupons corresponding to competitively-branded goods or for the selected goods at another retail outlet, and a personalized shopping list containing the selected goods and the aisle location in the selected retail outlet of the selected goods.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Burke	5,848,399	Dec. 08, 1998
Scroggie	6,014,634	Jan. 11, 2000 (Aug. 04, 1997)
Katz	6,055,513	Apr. 25, 2000 (Mar. 11, 1998)

“Internet Infinity Signs Exclusive Distribution Agreement With Zip Coupons,” (January 6, 1997) . (Zip Coupons)

“Excite Reports First Quarter 1999 Results,” (April 15, 1999). (Excite)

Claims 29, 30, and 32 through 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zip Coupons in view of Excite, Scroggie, and Burke.

Claim 31 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zip Coupons in view of Excite, Scroggie, Burke, and Katz.

Reference is made to the Examiner's Answer (mailed April 21, 2003) and Supplemental Answer (mailed December 29, 2004) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (filed February 10, 2003) and Reply Brief (filed June 27, 2003) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will the reverse the obviousness rejections of claims 29 through 40.

Claim 29 recites, in pertinent part, "third means responsive to the selection of one or more items of goods by the consumer to transmit to the respective consumer unit . . . a personalized shopping list containing the selected goods and the aisle location in the selected retail outlet of the selected goods." Claim 40 includes substantially the same limitation. As pointed out by appellants (Brief, page 13), of all of the references cited by the examiner, only Scroggie discloses transmitting to the consumer a shopping list of items selected by the consumer. In particular, Scroggie discloses (column 10, lines 14-16) that the final list includes everything the consumer has selected, including shopping list items and coupons. However, Scroggie does not mention anything about the aisle location of the selected items in the selected store. Recognizing this, the examiner (Supplemental Answer, pages 13-15) turns to Burke (as Zip Coupons and Excite do not disclose forming a shopping list and, therefore, they do not disclose transmitting the aisle locations of the items on the shopping list).

Burke teaches (column 1, lines 23-39, and column 2, lines 11-15) that previous systems for purchasing goods at home have failed because the product offerings have been in a textual format, which makes it cumbersome to sort through a large number of products, and the products have been the type that consumers would rather buy in person. Burke solves these problems by generating an image of a store shelf and displaying it to the consumer, thereby allowing the consumer to purchase items from home while

viewing the items as if in the store. Burke's graphical representation of the store is to improve the conditions for shopping at home. The examiner asserts (Supplemental Answer, pages 14-15) that in view of Burke's teachings it would have been obvious to transmit to the consumer the aisle locations of the selected items because "this enhances the invention's desirability to consumers through ease of locating desired products in a store and may enhance customer attraction to the merchant." However, we find nothing in Burke that would suggest transmitting aisle locations of items selected, as the purpose of Burke is to improve conditions for *shopping at home*, and aisle locations of selected items would be unnecessary while shopping at home. Thus, as the proposed combination of references lacks a claim limitation, the examiner has failed to establish a prima facie case of obviousness. Accordingly, we cannot sustain the obviousness rejection of claims 29 and 40, and their dependents, claims 30 and 32 through 39.


Regarding claim 31, the examiner has pointed to nothing in Katz, and we find nothing, that would cure the above-noted deficiency in the combination of Zip Coupons, Excite, Scroggie, and Burke. Accordingly, we cannot sustain the obviousness rejection of claim 31.

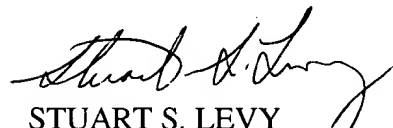
CONCLUSION

The decision of the examiner rejecting claims 29 through 40 under 35 U.S.C.
§ 103 is reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge


ANITA PELLMAN GROSS
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

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